

**REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-6 are presently active in this case. The present Amendment amends Claim 5 and adds Claim 6.

In the outstanding Office Action, Claim 5 was rejected under 35 U.S.C. § 102(a) as being anticipated by Yoshihiro (Japanese Patent No. 11-205458). Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sadao (Japanese Patent No. 11-074930) in view of Masafumi (Japanese Patent No. 11-032196).

In order to vary the scope of protection recited in the claims, new Claim 6 is added. New independent Claim 6 corresponds to Claim 1, but without means-plus-function language. Therefore, new Claim 6 is not believed to raise a question of new matter.

In response to the rejection of Claim 5 under 35 U.S.C. §102(a), Claim 5 is amended to recite "a transmission control means for adding a header with an information to the divisional data." Briefly recapitulating, amended Claim 5 relates to an e-mail communication terminal apparatus to be connected, by radio, to an e-mail system that is limited in an amount of data that can be communicated at one time, comprising a transmission control means for adding a header with information to the divisional data. As explained in Applicants' specification at page 2, lines 4-10, Applicants' invention improves upon conventional communication terminal apparatuses because if data having a larger amount than a limit amount is transmitted, the excess part of the data is discarded. The claimed invention thus leads to improved communication terminal apparatuses.

Turning now to the applied prior art, Yoshihiro discloses an electronic mail transfer device capable of transferring electronic mail to an economical pager terminal in a receivable format. However, the Yoshihiro patent fails to teach a transmission control means for adding

a header with an information to the divisional data. On the contrary, Yoshihiro explicitly teaches that an electronic mail is converted to a receivable format corresponding to the kind of the page terminal 7 and further discloses that electronic mail is divided into appropriate length so as to be simultaneously received and displayed by the pager terminal 7.<sup>1</sup>

Converting electronic mail to a receivable format corresponding to the kind of the page terminal, as disclosed in Yoshihiro, is not adding a header with an information to the divisional data.

Furthermore, the outstanding Office Action states that Yoshihiro teaches the invention according to Claim 5. However, Yoshihiro merely discloses a system that can transfer divided e-mails to a pager. Yoshihiro does not teach or suggest a terminal device that sends divided e-mails, as claimed by Applicants.

Therefore, Yoshihiro fails to teach or suggest the transmission control means recited in Applicants' Claim 5, so that Claim 5 is patentably distinct over the prior art. Accordingly, Applicants request reconsideration of the rejection based on the Yoshihiro patent.<sup>2</sup>

In response to the rejection of Claim 1-4 under 35 U.S.C. §103(a), Applicants respectfully request reconsideration of this rejection and traverse the rejection as discussed next.

Briefly recapitulating, Applicants' invention relates to an e-mail communication terminal apparatus to be connected to an e-mail system comprising a division control means for dividing transmission data into divisional data based on a predetermined data amount. As explained in Applicants' specification at page 2, lines 4-10, Applicants' invention improves upon conventional communication terminal apparatuses because if data having a larger

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<sup>1</sup> See Yoshihiro, e. g. the Abstract.

<sup>2</sup> See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

amount than a limit amount is transmitted, the excess part of the data is discarded. The claimed invention thus leads to improved communication terminal apparatuses.

Turning now to the applied prior art, Sadao discloses a electronic mail communicating method and communication terminal, wherein a transmission side divides image data into plural frames for effective information security<sup>3</sup> and reconstructs data of an electronic mail by combining two or more of these divided frames.<sup>4</sup> Sadao further teaches that two or more of each frames are transmitted and if packet disappearance takes place, reappearance of data can be performed in a receiving side.<sup>5</sup> Data which is going to be transmit as an electronic mail is divided, and this is replaced at random.<sup>6</sup>

Sadao therefore teaches a system to divide an e-mail into several data groups, wherein each group of data includes two or more randomly chosen frames. Sadao's goal is to achieve high information security and data transmission redundancy.<sup>7</sup> As acknowledged by the outstanding Office Action, Sadao does not teach a transmission network that is limited in the amount of data to be communicated. On the contrary, the Sadao reference proposes to send even more data over the network than effectively required, for security and redundancy.

The outstanding Office Action proposes to modify the Sadao system by incorporating certain features from the Masafumi reference. Masafumi discloses a communication terminal with e-mail function, able to determine a maximal e-mail size of the e-mail to transmit, and can divide the e-mail so that the e-mail does not exceed the above-mentioned maximum e-mail size.<sup>8</sup> Masafumi therefore teaches an e-mail system that is limited in an amount of data that can be communicated at one time.

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<sup>3</sup> See Sadao in the Abstract.

<sup>4</sup> See Sadao on page 3, paragraph 6.

<sup>5</sup> See Sadao on page 3, paragraph 7.

<sup>6</sup> See Sadao on page 5, paragraph 23.

<sup>7</sup> See Sadao on page 6, paragraph 32.

<sup>8</sup> See Masafumi on page 4, paragraph 10-11.

The outstanding Office Action proposes to modify the Sadao system by dividing the Sadao data on a predetermined data amount when the transmission data has an amount larger than the communicable data amount, as taught by Masafumi. The Sadao reference, however, teaches away from such modification. This is because Sadao teaches a randomized division of data to increase security. A division of data based on a predetermined amount would be in direct contradiction with the teaching of Sadao as it would decrease security, according to Sadao. In fact Sadao teaches to send more data over the network than is effectively required in order to increase security and redundancy. Therefore, reading Sadao, a person of ordinary skill in the art would not be motivated to modify the Sadao system by dividing the data based on predetermined amount. In other words, an attempt to bring in the isolated teaching of Masafumi's program of e-mail data division decision into the Sadao device would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.<sup>9</sup>

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,<sup>10</sup> and by "clear and particular" evidence<sup>11</sup> of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the Sadao device for data transmission security and

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<sup>9</sup> See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

<sup>10</sup> In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

<sup>11</sup> In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." ) (emphasis added).

transmission redundancy by incorporating Masafumi's program of division decision.

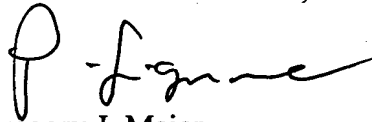
Without such motivation and absent improper hindsight reconstruction,<sup>12</sup> a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-4 are believed to be non-obvious and patentable over the applied prior art.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-6 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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<sup>12</sup> See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."